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Appl. No. 10/792,038

Section II. (REMARKS)

The claims pending herein are 1, 2, 4-7, 10, 14, 15, 17-21, 53-57 and 59.

Teleconference Between Applicants' Representative and Examiner Hoa Van Le

On July 6, 2007, Examiner Hoa Van Le telephoned the undersigned and we discussed the pending claims. Examiner Hoa Van Le misunderstood what claim 1 recited when he issued an Ex Parte Quayle Action and he admitted his error. He indicated that he would have to withdraw the Ex Parte Quayle Action and prepare another Office Action on the merits.

In addition, the undersigned indicated that claim 7 was intended to be a claim that depended from claim 1, wherein claim 7 included the species that depended from the genus claim.

Submission of Supplemental Information Disclosure

In compliance with the ongoing duty of disclosure imposed by 37 C.F.R. §1.56, applicant submits herewith a Supplemental Information Disclosure Statement and Certification Statement.

Withdrawn Claims

According to the Examiner, the claims withdrawn from consideration are 4, 6, 7 (formulas A-F and H to C2), 8, 9, 11-13, 18, 22-23 and 54-55 "with respect to the non-election of subspecies" (see July 9, 2007 Office Action, Continuation Sheet, lines 1-2). As previously introduced in the Response to the April 19, 2007 Ex Parte Quayle action, claims 8, 9, 11-13, 22, 23 have been cancelled without prejudice. Applicants hereby reserve the right to file continuation or divisional applications claiming the cancelled subject matter.

With regards to claims 4, 6, 18 and 54-55, no reasons have been provided why said claims have been withdrawn from consideration by the Examiner. For example, claims 4, 6, 54 and 55 depend directly from claim 1, further define claim 1, and throughout prosecution have never been separated from claim 1. Claim 18, depends directly from claim 17, which is presently being considered by the Examiner. At no point have claims 4, 6, 18 or 54-55 been considered "non-elected." Applicants request that the Examiner acknowledge same and examine said claims with elected claims 1, 2, 5, 10,

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14, 15, 17, 19-21, 53, 56, 57, and 59.

Claim 7 has been amended to depend from claim 1. Claim 7 includes the species that depend from the genus claim (claim 1). As is well established, upon allowance of the genus claim (claim 1), the species that include all of the limitations of the genus are allowable. Accordingly, all the formulas recited in claim 7 will be allowable upon allowance of claim 1.

Allowable Subject Matter

In the April 19, 2007 Office Action, the Examiner objected to claims 7, formula G only, and claim 57, indicating that they would be allowable if each were rewritten in independent form. Applicants acknowledge same.

Rejection of Claims and Traversal Thereof

In the July 9, 2007 Office Action:

claims 1, 2, 10, 19-21, 53 and 56 were rejected under 35 U.S.C. §102(e) as anticipated by, or, in the alternative under 35 U.S.C. §103(a) as being unpatentable over Yokoi et al. (U.S. Patent Application Publication No. 20040259761);

claims 1, 2, 5, 10, 19-21, 53 and 56 were rejected under 35 U.S.C. §102(e) as anticipated by, or, in the alternative under 35 U.S.C. §103(a) as being unpatentable over Hsu (U.S. Patent Application Publication No. 20050176603); and

claims 1, 2, 5, 10, 19-21, 53 and 56 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ichiki (U.S. Patent Application Publication No. 20010021488) in view of En et al. (U.S. Patent Application Publication No. 20040134682).

These rejections are traversed and reconsideration of the patentability of the pending claims is requested in light of the following remarks.

Rejections under 35 U.S.C. §102

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1. In the July 9, 2007 Office Action, the Examiner rejected claims 1, 2, 10, 19-21, 53 and 56 were rejected under 35 U.S.C. §102(e) as anticipated by, or, in the alternative under 35 U.S.C. §103(a) as being unpatentable over Yokoi et al. (U.S. Patent Application Publication No. 20040259761) (hereinafter Yokoi '761).

The Examiner previously argued in the April 13, 2006 Office Action that the elected claims were rejected as being anticipated in view of Yokoi '761. In response, applicants submitted a Declaration under 37 CFR §1.131 on August 17, 2006, wherein applicants attested to conception and reduction of practice of the presently claimed invention prior to such of the earliest claimed June 18, 2003 date of Yokoi '761 (a copy of the previously submitted Declaration is included herewith in **Appendix A**). Importantly, in the November 6, 2006 Office Action, the Examiner stated that:

"[a]pplicants submit a declaration under Rule 131, that the claimed embodiments are before the applied date of 18 June 2003 of Yokoi et al on the record. Accordingly, the rejections in the Office action mailed on 13 April 2006 are withdrawn." (see, the November 6, 2006 Office Action, page 3, lines 12-15, and the November 24, 2006 corrected Office Action, page 4, lines 1-4)

In other words, the rejection of claims 1, 2, 10, 19-21, 53 and 56 as being anticipated by Yokoi '761 has already been overcome. Withdrawal of said rejection is respectfully requested.

2. In the July 9, 2007 Office Action, claims 1, 2, 5, 10, 19-21, 53 and 56 were rejected under 35 U.S.C. §102(e) as anticipated by, or, in the alternative under 35 U.S.C. §103(a) as being unpatentable over Hsu (U.S. Patent Application Publication No. 20050176603).

Hsu has a filing date of November 5, 2004 and a priority date of February 11, 2004 (U.S. Provisional Patent Application No. 60/543,801). As introduced herein, applicants attested to conception and reduction of practice of the presently claimed invention prior to such of the earliest claimed June 18, 2003 date of Yokoi '761. Importantly, Yokoi '761 actually predates Hsu, and as such, the conception and reduction of practice of the presently claimed invention was clearly before the earliest claimed February 11, 2004 date of Hsu.

Withdrawal of the rejection of claims 1, 2, 5, 10, 19-21, 53 and 56 as being anticipated by Hsu is respectfully requested.

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Rejection under 35 U.S.C. §103(a)

In the July 9, 2007 Office Action, claims 1, 2, 5, 10, 19-21, 53 and 56 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ichiki (U.S. Patent Application Publication No. 20010021488) in view of En et al. (U.S. Patent Application Publication No. 20040134682) (hereinafter En). Applicants traverse such rejection.

Applicants' claim 1 recites:

"A cleaning composition including a quaternary base, at least one alkali or alkaline earth base, and at least one additional component selected from the group consisting of a chelator, an oxirane species, and combinations thereof, wherein said chelator comprises a species selected from the group consisting of: 1-amino-1,2,4-triazole; 1-amino-1,2,3-triazole; 1-amino-5-methyl-1,2,3-triazole; 3-mercapto-1,2,4-triazole; 3-isopropyl-1,2,4-triazole; naphthotriazole; 2-mercaptobenzoimidazole; 2-mercaptobenzothiazole; 5-aminotetrazole; 5-amino-1,3,4-thiadiazole-2-thiol; 2,4-diamino-6-methyl-1,3,5-triazine; thiazole; triazine; methyltetrazole; 1,3-dimethyl-2-imidazolidinone; 1,5-pentamethylenetetrazole; 1-phenyl-5-mercaptotetrazole; diaminomethyltriazine; mercaptobenzoithiazole; imidazoline thione; 4-methyl-4H-1,2,4-triazole-3-thiol; 5-amino-1,3,4-thiadiazole-2-thiol; tritoyl phosphate; indiazole; adenine; salicylamide; iminodiacetic acid; benzoguanamine; thiocyanuric acid; anthranilic acid; 3-mercaptopropanol; and combinations thereof, and said cleaning composition is useful for removing photoresist and/or sacrificial anti-reflective coating (SARC) materials from a substrate having such material(s) thereon."

Ichiki does not disclose the use of applicants' oxirane species and/or the specifically enumerated chelators. Moreover, there is no reason why one skilled in the art considering Ichiki would include applicants' oxirane species and/or the specifically enumerated chelators. Accordingly, at least one of the requirements needed to establish a *prima facie* case of obviousness have not been met.²

The inclusion of En does not cure the deficiency of Ichiki for the following reasons.

En relates to a process for manufacturing multilayer printed circuit boards. The only teaching relating

² Specifically, that the prior art reference must teach or suggest all the claim limitations

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to chelating agents in En is at paragraphs [0248]-[0256] whereby a copper surface is roughened using a cupric azole complex and an organic acid. It is noted that En does not motivate, teach or suggest applicants' oxirane species and/or specifically enumerated chelators.

There can be no motivation, teaching or suggestion to combine Ichiki and En because Ichiki would be rendered unsatisfactory for its intended purpose. As such, a *prima facie* case of obviousness does not exist. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As indicated, the lone teaching in En relating to the use of chelators relates to a composition for etchingly roughening a copper surface (as indicated in the chemical reactions provided in paragraph [0250] of En). In contrast, the method of Ichiki is described as having "extremely low corrosive effect on materials such as . . . copper . . ." (see Ichiki, paragraph [0036]). These are mutually exclusive teachings – Ichiki doesn't want the copper etched during cleaning while En is purposely removing copper. Clearly the combination of Ichiki and En would render Ichiki unsatisfactory for its intended purpose and as such, there can be no motivation or suggestion to combine Ichiki and En.

In conclusion, the combination of Ichiki with En does not make obvious applicants' claim 1 and claims 2, 5, 10, 19-21, 53 and 56 depending therefrom. Withdrawal of the rejection under §103 is respectfully requested.

Fees Payable

The fee under 37 CFR §1.17(p) of 180.00 for the Supplemental Information Disclosure Statement is authorized to be withdrawn from Deposit Account Number 13-4365 of Moore & Van Allen PLLC. Authorization is hereby given to charge any deficiency in applicable fees for this response to said Deposit Account.

Conclusion

Claims 1, 2, 4-7, 10, 14, 15, 17-21, 53-57 and 59 are in form and condition for allowance. If any additional issues remain, the Examiner is requested to contact the undersigned attorney at (919) 286-8090 to discuss same.

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Respectfully submitted,

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